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Number of pages including this cover sheet: **4**  
Date: **October 21, 2002**  
From: **Paul Marcoux**  
Telephone: **(418) 640-5988**  
E-Mail: **pmarcoux@ogilvyrenault.com**

To	Company	City	Fax
Helmer, Georgia L.	USPTO	Washington, USA	(703) 308-4242

**Message**

Barristers & Solicitors  
Patent & Trade-Mark Agents

500 Grande Allée East  
Suite 520  
Québec, Québec  
Canada G1R 2J7

Telephone (418) 640-5000  
Fax (418) 640-1500  
ogilvyrenault.com

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Patent  
Attorney's Docket No. 14149-4US PMMG/al#12  
AP  
10/21/02**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Louis-Philippe Vézina et al.  
Serial No.: 09/678,303                      Group Art Unit: 1638  
Filed: October 3, 2000                      Examiner: Helmer, Georgia L.  
For: PROMOTER FOR REGULATING EXPRESSION OF FOREIGN  
GENES

**RESPONSE TO RESTRICTION REQUIREMENT**

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, DC 20231

Sir:

In complete response to the Requirement for Restriction mailed on September 18, 2002, Applicants provisionally elect, albeit with traverse, to prosecute the claims of Group I, namely Claims 1 to 5.

Reconsideration of the Restriction Requirement is respectfully requested on the following ground.

The Claims of Group I are drawn to a promoter for regulating expression of foreign genes in a transgenic organism. It is well-known in the art that a promoter is a region of DNA involved in binding of RNA Polymerase to initiate transcription of a generally continuous gene or encoding DNA sequence. The function of a promoter cannot be used in a process materially different than when it is working as a sequence regulating the expression of a gene or an encoding DNA sequence. A promoter, by this definition, cannot be other thing than a promoter. Therefore, the DNA sequence is defined as such only when it is placed in conditions in any organism, or for example, in a transgenic

organism, to carry out this function. The use of the sequences described and claimed in the present invention as DNA hybridization probe, as argued by the Examiner, does not correspond and could not assume the function of a promoter.

The Claims of group II are drawn to a method for regulating expression of foreign genes in transgenic organisms. The method is defined by the use of the promoters described in the claims of group I of the present application. It is known in the art that each promoter as well as in eukaryotes as in prokaryotes, is activated and works distinctly to any other promoter by being activated by a unique combination of transcription factors and parameters. Therefore, as the promoters of the present invention are unique and have their own control systems and features working in a specific context, the methods in the present invention will distinctive features if it would make use of promoters other than the ones claimed in the group I in the present application.

Therefore, it is respectfully submitted that these two groups (Groups I and II) are indissociable. The search and examination of Claims 1 to 8 of the application can be made without serious burden on the Examiner.

Under the statute, an application may properly be required to be restricted to one or two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 - § 806.04(j)) or distinct (MPEP § 806.05 - § 806.05(i)).

According to the MPEP, there are two criteria for proper requirement for restriction between patentably distinct inventions:

1. The inventions must be independent (MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (MPEP § 806.05 - § 806.05(i)); and
2. There must be a serious burden on the Examiner if restriction is not required (see MPEP § 803.02 - § 806.04(a) - (j), § 808.01(a) and § 808.02)

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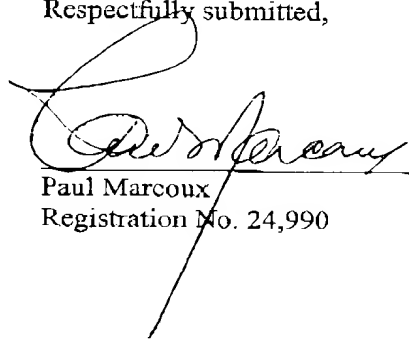
It is believed that the inventions as defined in Claims 1 to 8 are **NOT** independent and would not cause a serious burden on the Examiner. Thus, restriction should not be required in view of *In re Lee* (199 USPQ 108 (Deputy Asst. Com'r. for Pats 1978)). Therefore, the requirements of MPEP § 803 are not met.

Withdrawal of the restriction requirement and examination on Claims 1 to 8 on the merits are therefore respectfully requested.

In the event that there are any questions concerning this response, or the application in general, the Examiner is respectfully urged to telephone the undersigned so that prosecution of the application may be expedited.

Respectfully submitted,

By:

  
Paul Marcoux  
Registration No. 24,990

OGILVY RENAULT  
1981, McGill College  
Suite 1600  
Montreal (Quebec)  
Canada, H3A 2Y3

(418) 640-5988

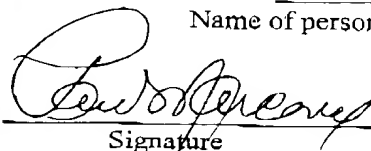
Date: October 21, 2002

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October 21, 2002

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